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| 09/492,459 | 01/27/2000 | Allen Claxton | PM 265648 | 9894 |
| 909 | 7590 | 01/23/2004 | EXAMINER | |
| PILLSBURY WINTHROP, LLP P.O. BOX 10500 MCLEAN, VA 22102 | | | KAZIMI, HANI M | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3624 | |

DATE MAILED: 01/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/492,459

Applicant(s)

CLAXTON ET AL.

Examiner

Hani Kazimi

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6 . 6) ☐ Other: _____

Art Unit: 3624

DETAILED ACTION

1. This application has been reviewed. Original claims 1-28 are pending. The objections and rejections cited are as stated below:

Priority

2. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. as follows:

3. If applicant desires priority under 35 U.S.C. 120 based upon a previously filed copending application, specific reference to the earlier filed application must be made in the instant application. For benefit claims under 35 U.S.C. 120, 121, or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications. This should appear as the first sentence of the specification following the title, preferably as a separate paragraph. The status of nonprovisional parent application(s) (whether patented or abandoned) should also be included. If a parent application has become a patent, the expression "now Patent No. _____" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application.

If the application is a utility or plant application filed on or after November 29, 2000, any claim for priority must be made during the pendency of the application and within the later of four

Art Unit: 3624

months from the actual filing date of the application or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2) and (a)(5). This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A priority claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed claim for priority under 35 U.S.C. 119(e), 120, 121 and 365(c). The petition must be accompanied by (1) a surcharge under 37 CFR 1.17(t), and (2) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional. The petition should be directed to the Office of Petitions, Box DAC, Assistant Commissioner for Patents, Washington, DC 20231.

Claim Objections

4. Claim 20 is objected to because of the following informalities:

There is a minor spelling error within claim 20, namely:

Claim 20 line 1: "farther" should apparently be --further--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

Art Unit: 3624

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 5, 8-11, 16, 19, 21, 22, and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In particular, claims 5, 8-11, 16, 19, 21, 22, and 24, the phrase "may be" or "can be" renders the claims indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). Appropriate correction is required.

Claim Rejections - 35 USC § 102

7. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

8. Claims 1-8, 10-19, and 21-28 are rejected under 35 U.S.C. 102(e) as being anticipated by

Art Unit: 3624

Asay et al. US patent No. 5,903,882.

Asay's reference uses the word "assurance" in stead of "warranty", and based on the specification of the present application, and the definition of the word "assurance" of the Asay reference (col. 5, lines 1-28), it is clear that both terms are the same, because the issuance of a warranty in the present application and a certificate of assurance in Asay perform the same functionality by providing a more secure transaction in an electronic transaction system.

Based on the definitions above, the examiner considers the "secondary certificate of assurance" of Asay to be the same as "warranty" in the present application.

Asay discloses a method and a corresponding electronic transaction system for managing reliance in an electronic transaction system comprising, an issuing bank (IB) providing transaction bearing liability (TBL) certificates to a subscriber, the subscriber forming and signing a transaction, the signed transaction including information contained in the TBL certificate, and forwarding the signed transaction to a relying party, the relying party forwarding an assurance request using an open network protocol based on the transaction to a relying party bank, the relying party bank issuing a signed warranty offer to the relying party that contains a key certified by a certification authority, the signed warranty offer being based at least on information in the TBL certificate, wherein the relying party bank only provides the signed warranty offer if the relying party is authorized to make a request for said warranty, (abstract, fig. 3, column 5, lines 1-28, column 10, lines 37-51, and column 11, line 1 thru column 15, line 12).

Art Unit: 3624

Asay discloses that the relying party bank bases a decision to sign the warranty offer on criteria which are defined through scripts including attributes of the TBL certificate, attributes concerning the issuing bank that are not contained in certificates, and attributes of the request for said warranty, the relying party bank treats each request from a particular relying party independently of all other requests from the same relying party, produces secure logs of all transactions, maintains a warranty account to track warranties that have been issued for each relying party, a record of outstanding warranties that have been issued for a group of relying party accounts, provides alert messages when certain warranty thresholds have reached, and makes requests for information from other systems to determine whether or not to issue the warranty offering (column 5, line 1 thru column 9, line 38, and column 23, lines 1-67).

Asay discloses that a request from a particular relying party includes information that allows the relying party bank to determine the policy regarding issuance of a signed warranty offer, and the issuing bank limiting a level of warranty by setting overall limits for any transaction (column 4, line 38 thru column 7, line 25).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3624

10. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

11. Claims 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Asay et al. US patent No. 5,903,882.

Claims 9, and 20, Asay fails to explicitly teach the step of rolling back the warranty being offered to the relying party if the relying party does not accept the offer within a set time limit.

Official notice is taken that rolling back an offer that is not accepted within a set time limit is old and well known in the art.

It would have been obvious to one of ordinary skilled in the art at the time the Applicant's invention was made to modify the teachings of Asay to include the step of rolling back the warranty being offered to the relying party if the relying party does not accept the offer within a set time limit because, it greatly improves the efficiency of the system by keeping track of all valid warranties (see Asay column 12, line 29 thru column 14, line 15).

Art Unit: 3624

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687 or 7658.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 1114.



**HANI M. KAZIMI
PRIMARY EXAMINER**

Art Unit 3624

October 1, 2003